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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/421,625 10/19/99 MARSH

E M122-1284

EXAMINER

021567 MM91/0404  
WELLS ST JOHN ROBERTS GREGORY AND MATKIN  
SUITE 1300  
601 W FIRST AVENUE  
SPOKANE WA 99201-3828

2811  
DATE MAILED:

ART UNIT	PAPER NUMBER
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04/04/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/421,625	MARSH, EUGENE P.
<b>Examiner</b>	<b>Art Unit</b>	
Hung K. Vu	2811	

-- Th MAILING DATE of this communication app ars on th c v r sh et with th correspond nce addr ss --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 19 October 1999.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 57-76 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 57-76 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

15) Notice of References Cited (PTO-892)

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,5,6.

18) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

19) Notice of Informal Patent Application (PTO-152)

20) Other: \_\_\_\_\_

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 57-76 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 5,990,559. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-3 are generic to claims 1-20 of U.S. Patent No. 5,990,559, thus allowing unjustified or improper timewise extension of the "right to exclude" granted by a U.S. Patent No. 5,990,559. Further, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form a silicon substrate comprising monocrystalline because it is convention to form a monocrystalline silicon substrate.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claim 57 is rejected under 35 U.S.C. 102(e) as being anticipated by Aoki et al. (PN 6,033,953, of record).

Aoki et al. discloses an integrated circuit comprising hemispherical grain platinum (38'). Note Figures 1A-14 (especially Figures 1B-1D) of Aoki et al..

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 58-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki et al. (PN 6,033,953, of record).

Aoki et al. discloses a capacitor comprising,

A first capacitor electrode (38) over a substrate (1);

A second capacitor electrode (37);

A dielectric layer (40) between the first and second capacitor electrodes;

Wherein at least one of the first and second capacitor electrodes comprises a roughened platinum layer. Note Figures 1A-14 (especially Figures 1B-1D) of Aoki et al..

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Aoki et al. discloses the substrate is a silicon substrate. Aoki et al. does not disclose the silicon substrate is monocrystalline. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the substrate of Aoki et al.'s by monocrystalline because it is convention to form an integrated circuit on a monocrystalline silicon substrate.

With regard to claims 58, 61-64, 68, 70, and 72, although Aoki et al. does not teach the exact the area of a substrate, the thickness of a platinum layer, and the height of pedestals, as that claimed by Applicants, however, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the platinum layer and pedestals of Aoki et al.'s having a desire thickness and height on a desire area of the substrate, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

*In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

With regard to claims 59 and 69, Aoki et al. ~~wherein~~<sup>shows</sup> the platinum layer comprises hemispherical grain platinum.

With regard to claims 60 and 71, although Aoki et al. does not teach the exact the shape of the substrate, as that claimed by Applicants, the shape differences are considered obvious design choices and are not patentable unless unobvious or unexpected results are obtained from these changes. It appears that these changes produce no functional differences and therefore would have been obvious. Note *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Circ. 1990).

With regard to claim 65, Aoki et al. discloses the circuit further comprising an adhesion layer (40) between the platinum layer and the substrate, the adhesion layer comprising at least one of titanium nitride.

With regard to claims 66 and 75, Aoki et al. discloses wherein the pedestals terminate in dome-shaped tops.

With regard to claims 67 and 76, Aoki et al. discloses wherein the pedestals terminate in hemispherical tops.

With regard to claim 73, Aoki et al. discloses wherein both capacitor electrodes comprise platinum, but only one of the capacitor electrodes comprises the roughened platinum layer.

With regard to claim 74, Aoki et al. does not disclose wherein both capacitor electrodes comprise roughened platinum layers. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form both capacitor electrodes of Aoki et al.'s comprise roughened platinum layers in order to increase capacitor's surface area.

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*Conclusion*

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung K. Vu whose telephone number is (703) 308-4079. The examiner can normally be reached on Mon-Thurs 7:00-5:30, Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Thomas can be reached on (703) 308-2772. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Vu

March 23, 2001

**Steven Loke**  
Primary Examiner

